

**REMARKS**

**Summary of the Office Action**

The disclosure stands objected to because of minor informalities.

The drawings stand objected to under 37 C.F.R. § 1.83(a).

Claims 7, 13, and 14 stand objected to because of informalities.

Claims 6 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 14 stands rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Claims 1-3, and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Asada (EP 1,187,110) (hereinafter "Asada").

Claims 7, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Iida (U.S. Patent No. 6,424,605) (hereinafter "Iida").

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Asada as applied to claims 1-3 above, and further in view of Horita (U.S. Patent No. 6,469,965) (hereinafter "Horita").

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Asada and Horita as applied to claims 1-4 above, and further in view of Yasuda et al. (U.S. Patent No. 6,221,455) (hereinafter "Yasuda").

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Asada as applied to claims 1-3 above, and further in view of Kitaura et al. (U.S. Publication No. 2002/0122366) (hereinafter "Kitaura").

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida as applied to claim 7 and 13 above, and further in view of Asada.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida and Asada as applied to claims 7-9 above, and further in view of Horita.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida, Asada, and Horita as applied to claims 7-10 above, and further in view of Yasuda.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida and Asada as applied to claims 7-9, and 13 above, and further in view of Kitaura.

#### **Summary of the Response to the Office Action**

Applicant has amended claims 1, 6, 7, 10 and 12-14 to differently describe embodiments of the disclosure of the instant application's specification. Claims 8 and 9 have been canceled without prejudice or disclaimer. Accordingly, claims 1-7 and 10-14 remain currently pending for consideration. Applicant has also implemented minor revisions to the specification to improve its form.

#### **Objection to the Disclosure**

The disclosure stands objected to because of minor informalities. Applicant has implemented minor revisions to the specification to improve its form in light of the Examiner's concerns described at page 2, section 1 of the Office Action.

The Examiner refers to paragraphs numbers such as [0017], [0018] and [0019] in the objection to the disclosure. Applicant notes that the specification filed in the instant application

did not include such paragraph numbers. It appears that the Examiner is referencing the published version of this application with regard to these paragraph numbers. Accordingly, Applicant has amended the corresponding portions of the specification as originally filed, as indicated by the page and line numbers specified in the foregoing amendments to the specification in this Amendment.

In this regard, the Examiner objects to paragraph [0062] and requires a correction of the reference to “step 510” to read “step S10.” Applicant respectfully traverses this particular requirement because the corresponding portion of the originally filed specification at page 12, line 11 correctly refers to “step S10” at this portion of the specification. This portion of the specification has never been amended by Applicant to date in this application. Accordingly, no amendment is deemed necessary in this regard at this time. The Examiner is requested to perform the examination based on the papers filed by Applicant in this application. If an Examiner’s Amendment is required to correct a USPTO error in the publication of this application in this specific regard, the Examiner is requested to proceed with such. If Applicant’s understanding is incorrect in some regard, clarification is requested in the next Office Communication. Withdrawal of the objection to the disclosure is requested.

#### **Objection to the Drawings**

The drawings stand objected to under 37 C.F.R. § 1.83(a). This objection is respectfully traversed for at least the following reasons. The Examiner asserts at pages 2-3 of the Office Action that the “distance from a beam-incidence-side surface of the medium to the corresponding-information recording layer, as recited in claims 4, 5, 10 and 11 must be shown.”

Applicant respectfully submits that this distance indicated by the Examiner is clearly shown in Fig. 4A of the instant application. The subject distance is a distance from a bottom surface of an optical disc DK1 to an information recording layer L1 thereof. See, for example, page 10, lines 1-10 of the instant application's specification, which describes that "[i]n addition, the distance from the disk (DK1) surface, ... in the monolayer disk categorized into the high-density DVD." Accordingly, withdrawal of the objection to the drawings is respectfully requested.

#### **Objection to Claims 7, 13, and 14**

Claims 7, 13, and 14 stand objected to because of informalities. Applicant has amended claims 7, 13, and 14 to improve the form of the claims by incorporating the Examiner's helpful suggestion provided at page 3, section 3 of the Office Action. Accordingly, withdrawal of the objections to claims 7, 13, and 14 is respectfully requested.

#### **Rejection under 35 U.S.C. § 112, second paragraph**

Claims 6 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended claims 6 and 12 in response to the Examiner's comments provided at page 4, section 5 of the Office Action. Applicant respectfully submits that these amendments are fully supported by the specification and drawings of the instant application, for example, at Fig. 7 and page 14, line 28 to page 15, line 16 of the specification which teaches "(Second embodiment) Referring to Fig. 7, ... next to the adjustment layers." Applicant respectfully submits that claims 6 and 12, as amended, fully comply with the requirements of 35

U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

**Rejection under U.S.C. § 101**

Claim 14 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended claim 14 to be directed to a computer-readable recording medium in which a program is recorded in order to comply with 35 U.S.C. § 101. Accordingly, withdrawal of the rejection under 35 U.S.C. § 101 is respectfully requested.

**Rejections under 35 U.S.C. § 102(b) and 103(a)**

Claims 1-3, and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Asada. Claims 7, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Iida. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Asada as applied to claims 1-3 above, and further in view of Horita. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Asada and Horita as applied to claims 1-4 above, and further in view of Yasuda. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Asada as applied to claims 1-3 above, and further in view of Kitaura. Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida as applied to claim 7 and 13 above, and further in view of Asada. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida and Asada as applied to claims 7-9 above, and further in view of Horita. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida, Asada, and Horita as applied to claims 7-10 above, and further in view of Yasuda. Claim 12 stands rejected

under 35 U.S.C. § 103(a) as being unpatentable over Iida and Asada as applied to claims 7-9, and 13 above, and further in view of Kitaura. Applicant has amended claims 1, 6, 7, 10 and 12-14 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicant respectfully submits that Asada discloses a two-layered disc. Recording prohibition information is recorded in only a single recording layer, so only one-time focus control is required for reading the recording prohibition information.

On the other hand, Applicant respectfully submits that an important feature of newly-amended independent claim 1 is that "in a lead-in area of the information recording medium, only the single corresponding-information recording layer has a reflection layer, and each of the information recording layers has no reflection layer." Applicant respectfully submits that this amendment is fully supported by the specification and drawings of the instant application. For example, in Fig. 4A. Also, page 9, lines 24-29 of the specification, which teaches, "[i]n the case of the lead-in area LA, as shown in Fig. 4A, the reflection layer RF1 is provided with only the first information recording layer L1, ... By contrast, each of the remaining information recording layers L2 and L4 has no reflection layer."

Applicant respectfully submits that at least this feature of newly-amended independent claim 1 is not disclosed, nor even suggested, by Asada. Similar features have also been added to the remaining independent claims 7, 13 and 14. Applicant respectfully submits that the applied Iida reference does not cure the deficiencies discussed above with regard to Asada and, as a result, Iida also does not teach or suggest these newly-added features. Accordingly, similar arguments as

discussed above with regard to newly-amended independent claim 1 also apply to newly-amended independent claims 7, 13 and 14.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because neither Asada nor Iida, whether taken singly or combined, teach or suggest each feature of independent claim 1, 7, 13 or 14, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that dependent claims 2-6 and 8-12 are allowable at least because of their dependence from independent claim 1 or 7, and the reasons set forth above. Moreover, Applicant respectfully submits that the additionally applied references to Horita, with respect to claim 4, Yasuda, with respect to claim 5, Kitaura, with respect to claim 6, do not cure the deficiencies discussed above with regard to Asada and Iida.

### **CONCLUSION**

In view of the foregoing, Applicant submits that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this

response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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